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09/955,548	09/17/2001	Akira Kibashi	JP920000200US1	9802

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EXAMINER

PATEL, GAUTAM

ART UNIT	PAPER NUMBER
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2655

DATE MAILED: 04/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/955,548

**Applicant(s)**

KIBASHI ET AL.

**Examiner**

Gautam R. Patel

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **Response to Amendment**

1. This is in response to amendment filed on 12-14-04.
2. Claims 1 and 3 remain for examination.
3. Applicant's arguments regarding objection of drawings have been fully considered and objection has been withdrawn.

### **Claim Rejections - 35 U.S.C. § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1 and 3 are rejected under 35 U.S.C. § 102(e) as being anticipated by Arai et al., US. patent 6,169,710 (hereafter Arai).

As to claim 1, Arai discloses the invention as claimed [see Figs. 1-3] including a reader/writer, a determiner, a retry commander and a data overwrite logic, comprising:

a reader/writer [fig. 1, unit 3] for reading and writing data from/to a storage medium [optical disc] [col. 2, lines 28-37];

a determiner [fig. 1, unit 3] for determining whether data can be successfully read by said reader/writer;

a retry commander [fig. 1, unit 3] for commanding said reader/writer to retry to read the data if said determiner determines that the data read operation can be unsuccessful; and

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a data overwrite logic [fig. 1, unit 3] for overwriting the storage medium with the read data if a command has been issued a predetermined number of times or more by said retry commander when the data read operation is determined to be successful by said determiner [col. 2, line 28 to col. 3, line 23].

### **Claim Rejections - 35 U.S.C. § 103**

5. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1 and 3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Arai et al., US. patent 6,169,710 (hereafter Arai) in view of Kulakowski et al., US. patent 5,233,584 (hereafter Kulakowski).

As to claim 1, Arai discloses the invention as claimed [see Figs. 1-3] including a reader/writer, a determiner, a retry commander and a data overwrite logic, comprising:

a reader/writer [fig. 1, unit 3] for reading and writing data from/to a storage medium [optical disc] [col. 2, lines 28-37];

a determiner [fig. 1, unit 3] for determining whether data can be successfully read by said reader/writer;

a retry commander [fig. 1, unit 3] for commanding said reader/writer to retry to read the data if said determiner determines that the data read operation can be unsuccessful; and

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a data overwrite logic [fig. 1, unit 3] for overwriting the storage medium with the read data if a command has been issued a predetermined number of times or more by said retry commander when the data read operation is determined to be successful by said determiner [col. 2, line 28 to col. 3, line 23].

Arai discloses all of the above elements, including a data saving logic [fig. 1 unit 3] for saving data to be overwritten in a memory [fig.1, unit 4] [col. 2, line 28 to col. 3, line 23]. Arai does not specifically disclose type of the memory section where data is saved, such as nonvolatile memory or ROM.

However, use and application of nonvolatile memory or ROM is very well known in the art for very long time [for example Intel computer architecture] and almost all newer system has these feature on the disc to save ID, control functions etc.

Also Kulakowski clearly discloses that it well known in the art to store the data to be rerecorded [overwritten] in a ROM [col. 2, lines 53-58 and col. 4, line 59 to col. 5, line 34].

Both Arai and Kulakowski are interested in improving the overwrite mechanism of the disk both shows ID fields [pointers] for the new data to be written, thus defining location information.

One of ordinary skill in the art at the time of invention would have realized that the system of Arai would have been sensitive to noise that is associated with RAM type memory and it may destroy sensitive data while trying to write another data on the disk, and it would be useful to have a portion of the memory allocated as nonvolatile memory to save important and/or old data.

Therefore, it would have been obvious to have used a ROM [or nonvolatile memory in the system of Arai as taught by Kulakowski because one would be motivated to prevent destruction of important data in the system of Arai and provide better reliability for over all operation of the system.

7. The aforementioned claim 3, recites the following elements inter, alia disclosed in Arai:

a pointer information changer [ID changer, fig. 1, unit 3] for changing the pointer information which points to the storage location of the data to be read on the storage medium

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after the data was saved by said data saving logic or overwritten by said data overwrite logic [col. 3, line 55 to col. 4, line 20].

8. Applicant's arguments filed on 12-14-04 have been fully considered but they are not deemed to be persuasive for the following reasons:

In the REMARKS, the Applicant argues as follows:

A) That: "Examiner states that "use and application of nonvolatile memory or ROM is very well known in the art for a very long time .." Under MPEP 2144.03, Applicant respectfully requests Examiner to cite a reference in support of his position." [page 6, para. 1; REMARKS].

FIRST: The Examiner has already supplied this kind reference in his last office action namely Kulakowski, for this type of application of ROM.

SECOND: To expedite the prosecution, the Examiner has also supplied six more references [listed below in "other art"]. Each one of these references shows nonvolatile memory or ROM and why and how it should be used including data saving logic and device to perform theses functions. Reference 5,524,190 [ Schaeffer] even claims these aspects and even discloses reason for combination.

B) That: "The references that the Examiner made with respect to a ROM in Kulakowski et al. in his office action, refer to a medium [original emphasis] in which a portion of it is a ROM and another portion is a rewritable technology. Thos references deal with reading data from ROM portion and dealing with ECC issues that arise from a faulty read, not using a ROM or nonvolatile memory as part of overwrite process to maintain data integrity as the present invention does". [page 6, para. 2; REMARKS].

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FIRST: As to the arguments regarding ECC issues , it should be pointed out that what else Kulakowski does is irrelevant as long as he is storing data in ROM, especially in the light of the fact the claim starts with words "comprising".

SECOND: Kulakowski was NOT used for the overwrite process or logic, Arai was.

THIRD: Saving data form the latest state of the computer has been integral part of the computer systems for a very long time as following art clearly shows.

C) That: "Kulakowski et al. can not inherently provide a motivation to combine itself with Arai et al. Even if Kulakowski et al. was to suggest such a combination, there is no indication in Kulakowski et al. or any of the cited art that such a combination would be successful" [page 6, para. 3; REMARKS].

It should be pointed out that:

The test of the obviousness is:

"whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention,". As shown in *In re Gorman*, 933 F. 2d at 986, 18 USPQ2d at 1888.

Subject matter is unpatentable under section 103 if it "'would have been obvious .... to a person having ordinary skill in the art.' While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, **it is not necessary that the cited references or prior art specifically suggest making the combination.**" As shown in *In re Nilssen*, 851 F. 2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988).

Such suggestion or motivation to combine prior art teachings can derive solely from the existence of a teaching, which one of ordinary skill in the art would be presumed to know, and the use of that teaching to solve the same [or] similar problem which it addresses." As shown in *In re wood*, 599 F. 2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979).

**"In sum, it is off the mark for litigants to argue, as many do, that an invention cannot be held to have been obvious unless a suggestion to combine prior art teachings is found in a specific reference."** As shown in *In re Oetiker*, 24 USPQ2d 1443 (CAFC 1992).

Accordingly, Kulakowski or Arai is not required to disclose or specifically suggest particular elements. Instead the measure is what the teachings of Kulakowski would suggest to one of ordinary skill in the art, not what Kulakowski specifically suggests.

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### **Other prior art cited**

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Schaeffer et al. (US. patent 5,524,190) "Command object ...".
- b. Larsson et al. (US. patent 6,408,326) "Method and system for ...".
- c. Johnson et al. (US. patent 6,163,338) "Apparatus and method ...".
- d. Hallowell et al. (US. patent 5,822,600) "Dynamic hibernation time .. ...".
- e. Nurmi et al. (US. patent 6,816,974) "Method and arrangement ...".
- f. Horie (US. patent 6,671,249) "Optical recording medium ...".

10. **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a).

Applicant's amendment necessitated the new grounds of rejection presented in this office action. Accordingly, **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

### **Contact information**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam R. Patel whose telephone number is 571-272-7625. The examiner can normally be reached on Monday through Thursday from 7:30 to 6.

The appropriate fax number for the organization (Group 2650) where this application or proceeding is assigned is 703-872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Doris To can be reached on (571) 272-7629.



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Any inquiry of a general nature or relating to the status of this application should be directed to the Electronic Business Center whose telephone number is 866-217-9197 or the USPTO contact Center telephone number is (800) PTO-9199.

Gautam R. Patel  
Primary Examiner  
Group Art Unit 2655



**GAUTAM R. PATEL**  
**PRIMARY EXAMINER**

April 8, 2005